

#7/Re consider
2-4-04
JGRECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE JAN 22 2004

In re Application of
diGirolamo et al.
Serial No.: 10/058,958
Filed: January 28, 2002
For: Wall Structure
Attorney's Docket No: 4782-022

)
)
)
)
)
)
)
)

Patent Pending
Examiner: Ms. Yvonne M. Horton
Group Art Unit: 3635

OFFICIAL

Raleigh, North Carolina
January 22, 2004

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NON-FINAL OFFICE ACTION MAILED OCTOBER 22, 2003

In response to the official office action of October 22, 2003 relating to the above-identified United States patent application, the Patent and Trademark Office is respectfully requested to reconsider the present application in light of the comments to follow.

Claims 1-6 stand rejected under 35 USC §102 as being anticipated by the patent to Turner, U.S. Patent No. 5,315,803. Claims 7-10 and 12-14 stand rejected under 35 USC §103 as being unpatentable over Turner in view of the patent to Ressel, U.S. Patent No. 5,657,606. Claims 16-18, 24-29 stand rejected under 35 USC §103 as being unpatentable over Turner in view of Ressel.

First, attention will be directed to the anticipation rejection. In order to anticipate, each and every element and limitation of a claim must be present in a single reference. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). That is, the identical invention, as

claimed, must be shown in as complete detail as contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Expressed in another way, in order for anticipation to exist, not only must a single reference show each and every limitation of the claim, but the single prior art reference must show the identical invention as precisely described in the claim. Indeed, anticipation requires that the single prior art reference disclose every element and limitation of the claimed invention arranged in the same manner as claimed. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Claim 1 is directed to a wall structure including a pair of opposed members, a plurality of spaced apart studs connected between the opposed members, openings formed in the respective studs and at least one diagonal brace extending through the openings of the studs. It is important to appreciate that claim 1 is restricted to a wall structure where the diagonal brace extends through the formed openings in the studs.

The Examiner takes the position that claim 1 is anticipated by the Turner patent. However, a close review of the Turner patent shows that it does not anticipate claim 1. In particular, reference is made to Figure 1. The Examiner is correct in noting that Turner discloses a diagonal brace.

However, the Examiner indicates that there are openings in the studs through which the diagonal brace extends. In particular, the Examiner points to "openings (15) in the studs." The reference numeral 15 does not refer to an opening 15 in the stud. Stud 14 is made of wood and there are no openings provided in the same. Reference numeral 15 refers to a cut-out formed in the brace 10, 11. In particular, at column 3 of the Turner patent, the inventor states: "at each place where the brace is fixed, a saw cut as indicated at 15 is made to accommodate closely

one flange 13 of the brace. Thus, by providing a cut-out 15 in the brace, a brace extends around the stud – not through the stud.

Accordingly, the Turner patent does not and cannot anticipate claim 1 of the present application.

All of the rejections are based on a factual determination that the stud 14 in Turner includes an opening through which the diagonal brace passes. With due respect, this is not the case and there is no factual basis for this finding. Therefore, for the same reasons articulated above, the rejection of all other claims is improper because again these rejections are premised on the finding that the brace of Turner extends through openings within the studs.

If the present response does not place the application in condition for allowance, the Examiner is respectfully requested to telephone the undersigned in order that an expeditious effort can be made to place the present application in condition for allowance.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:



Larry L. Coats
Registration No. 25,620

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844

CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE TRANSMITTED TO THE UNITED STATES PATENT AND TRADEMARK OFFICE, FAX NUMBER (703) 305-7687, ON THE DATE SHOWN BELOW.

SIGNATURE: Carlton J. Womble

NAME: Carlton J. Womble, Legal Assistant

DATE: January 22, 2004